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Lucian Hirsch

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STAAS & HALSEY LLP

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LUCIAN HIRSCH and ALFRED SCMIDBAUER

Appeal 2011-003953
Application 09/700,093
Technology Center 2100

Before JAMESON LEE, KARL D. EASTHOM, and RAMA G. ELLURU,
Administrative Patent Judges.

ELLURU, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 2-34, all the pending claims in the application. The Real Party in Interest is Siemens Aktiengesellschaft. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

The Applied Prior Art

| | | |
|-----------|-----------------|---------------|
| CARRETTA | WO 96/20547 | Jul. 4, 1996 |
| TANAKA | US 5,903,568 | May 11, 1999 |
| MEANDZIJA | US 6,404,743 B1 | Jun. 11, 2002 |

The Rejections on Appeal

Claims 17, 30-33 were finally rejected under 35 U.S.C. § 103(a) as obvious over Tanaka and Carretta. (Ans. 4-10).

Claims 2-16, 18-29, and 34 were finally rejected under 35 U.S.C. § 103(a) as obvious over Tanaka, Carretta, and Meandzija. (Ans. 10-16).

The Invention

The claimed invention relates a method and communication system for processing state information in a management network comprising various management levels. (Spec. 1, ll. 9-12). The state information is transmitted between an agent of one management level and at least one manager of a next higher management level. (*Id.* at ll. 12-14).

Claim 30 is reproduced below:

30. A method for state realignment of state information in a communication system by way of a management network having a number of management levels, comprising:

storing, at an agent of a first management level together with managed objects, state information which defines a state of network resources associated with the managed objects stored in the agent, where each item of state information, for which state realignment shall be performed, can assume at least two values;

defining a normal state of the state information by one of a predefined value and a combination of predefined values;

sending, to the agent from a manager at a second management level above the first management level, a request message for performing the state realignment after communication between said manager and said agent is established initially or following a period during which communication was not guaranteed;

comparing by the agent, the state information stored by the agent for deviation from a normal state of the state information; and

sending, by the agent to the manager in response to the request message, only deviant state information indicating deviation from the normal state of the state information previously stored by the agent and not sending state information which does not deviate from the normal state of the state information.

DISCUSSION

35 U.S.C. § 103(a): Rejection of Claims 17 and 30-33 over Tanaka and Carretta

As an initial matter, we note that “a claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). In *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999), the Federal Circuit explained that:

If . . . the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the

preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.

The preamble of the claims at issue includes the phrase “*for state realignment*” (emphasis added) and it indicates the purpose or intended use of the steps recited in the body of the claim.

The claimed subject matter is already clear and complete without adding any additional limitations by way of the term “for state realignment” in the preamble. The term “for state realignment” is not needed to breathe life and meaning to the body of the claims. *See Pitney Bowes*, 182 F.3d at 1305 (the preamble limits a claim if it recites essential structure or is otherwise “necessary to give life, meaning, and vitality” to the claim); *IMS Tech., Inc. v. Haas Automation*, 206 F.3d at 1422, 1434–35 (Fed.Cir.2000) (a preamble is not limiting where it “merely gives a descriptive name to the set of limitations in the body of the claim that completely set forth the invention.”). The claims at issue recite all the steps necessary to whatever extent it has to do with “for state realignment.” *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir.1997) (“‘[c]omprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim”). Thus, Appellants cannot further narrow the scope of the claims by bringing in extraneous limitations not required by the claims.

The claims require several steps “for state realignment.” Claim 30, for example, requires that the agent “compar[e] . . . the state information

stored by the agent for deviation . . .” (“comparing step”) and “send . . . to the manager *in response to the request message* . . . only deviant state information indicating deviation.”¹ (Emphasis added). The Examiner finds that Tanaka teaches the “comparing” step. (Ans. 8). Specifically, as the Examiner explains, Tanaka’s lower-layer agent 107 *gives an event notification* to the lower-layer manager 106. (*Id.* (citing Tanaka col. 10, ll. 45-48)) (Emphasis added).

Appellants argue that Tanaka’s event notification is not performed “in response to a request,” as recited, from anything. (App. Br. 6). The Examiner responds to this argument, in relevant part, as follows:

Tanaka teaches an operation that represents an operation request given to a managed object and the operation can be a request, response, or an event notification (col. 7, lines 3 - 10). These operations are the same as the service functions. Therefore, an event notification is a type of service function . . .

(Ans. 17, 21). In their reply, Appellants do not argue that the Examiner has failed to show how Tanaka’s event notification is performed in response to a request. Appellants, however, argue that the examiner has not cited support for the assertion that the operations listed at column 7, lines 3-5 of Tanaka, which includes the item of an event notification, are the same as the “service functions” taught by Tanaka. (Reply Br. 5). We disagree.

As the Examiner explains, Tanaka teaches that a lower-layer agent performs a “service function” in response to a request from a lower-layer manager, which in turn performs a service function in response to a request from an upper-layer manager. (Ans. 7). Specifically, Tanaka teaches a

¹ Independent claims 17 and 31 include similar limitations.

lower-layer manager 106 for performing a service function in response to a request from the upper-layer manager 101, and a plurality of *lower-layer agents 107 for performing a service function* in response to a request from the lower-layer manager 106. (Tanaka col. 6, ll. 42-46) (Emphasis added). Importantly, Tanaka also teaches that the lower-layer agent 107, which Tanaka teaches performs service functions, gives the event notification. (Tanaka col. 10, ll. 45-47). Thus, we agree with the Examiner that Tanaka suggests that an event notification is a type of service function.

Appellants also argue that the combination of Tanaka and Carretta is improper because Tanaka does not recite the term “state realignment.” (App. Br. 5; 7). It is irrelevant that a prior art reference does not use the same words as those recited in the claims as long as the reference alone, or in combination, accounts for and satisfies every claimed limitation.

Lastly, Appellants argue that the combination of Tanaka and Carretta is improper. (App. Br. 7). Appellants contend that the reason given for modifying Tanaka to incorporate the features of Carretta is a common benefit of the claimed invention and Carretta. (*Id.*) According to Appellants, however, the Examiner has not shown why of one of ordinary skill in the art would look to Carretta to modify Tanaka because Tanaka is not related to “state realignment” and there is no value in economizing state information in the Tanaka system. (*Id.*) We disagree and conclude that the Examiner provides an articulated reasoning with a rational underpinning for combining Tanaka and Carretta. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Specifically, the Examiner finds that one of ordinary skill in the art would look to Carretta to modify Tanaka because “sending of only the variable state values different from default [as taught by Carretta] is a

sending procedure which allows economizing the state information to be sent to a MANAGER so that the latter can recover its own alignment.” (Ans. 27 (citing Carretta p. 37, l. 34 - p. 38, l. 2)).

We have considered only the arguments presented by the Appellant. Arguments which were not presented before us are considered as waived. Also, to the extent Appellants raise new arguments in their Reply Brief, we do not consider them. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (“informative”²) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

For the foregoing reasons, we sustain the rejection of claims 17 and 30-33 under 35 U.S.C. § 103 as obvious over Tanaka and Carretta, and of claims 2-16, 18-29, and 34 falling therewith³. *See* 37 C.F.R. § 41.37(c)(l)(vii).

CONCLUSION

The rejection of claims 17, 30-33 under 35 U.S.C. § 103(a) as obvious over Tanaka and Carretta is *affirmed*.

The rejection of claims 2-16, 18-29, and 34 under 35 U.S.C. § 103(a) as obvious over Tanaka, Carretta, and Meandzija is *affirmed*.

² The “informative” status of this opinion is noted at the following Board website: <http://www.uspto.gov/ip/boards/bpai/decisions/inform/index.jsp>.

³ Separate patentability was not argued for the claims 2-16, 18-29, and 34 rejected under § 103(a) on various combinations including Tanaka and Carretta. Appellants argued the patentability of these claims by merely stating that none of the additional references overcame the deficiencies of Tanaka and Carretta (App. Br. 8).

Appeal 2011-003953
Application 09/700,093

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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